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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1957

No. 896

FREDERICK C. BERSWORTH and THE DOW CHEMICAL COMPANY, *Petitioners*

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS, *Respondent*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above entitled case January 9, 1958.

### OPINIONS BELOW

The opinion of the Board of Appeals of the United States Patent Office is unreported (*infra*, p. 5a). Its opinion in response to the Request for Reconsideration

is unreported (*infra*, p. 8a). Its opinion in response to a Renewed Petition for Reconsideration and Rehearing is unreported (*infra*, p. 10a).

The memorandum of the District Court is reported at 116 U.S.P.Q. 87, — F. Supp. — (*infra*, p. 11a).

Findings of Fact and Conclusions of Law of the District Court are unreported (*infra*, 14a).

The opinion of the Court of Appeals is reported at 116 U.S.P.Q. 79 and in the Official Gazette of the United States Patent Office for February 18, 1958, Volume 727, page 445, — F. 2d — (*infra*, p. 19a).

## JURISDICTION

The judgment of the Court of Appeals was rendered on January 9, 1958. On January 24, 1958, within the period defined by the Rule of the Court of Appeals, petitioners filed a Petition for Rehearing and Alternative Petition for Rehearing *en banc*.

Rehearing was denied February 28, 1958 by Orders of the Court of Appeals, *infra*, p. 37a.

Petitioners thereupon filed a Motion for Stay of the mandate of the Court, pending preparation of this Petition for Certiorari. The Motion was granted and time extended up to and including April 3, 1958, *infra*, p. 37a. A motion for a further 30 days' stay was filed on or about April 2, 1958.

The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254(1), *infra*, p. 2a.

## QUESTIONS PRESENTED

Title 35, United States Code, Section 112 (*infra*, p. 1a) provides that a patent application shall include a specification which shall contain a written descrip-

tion of the invention in language sufficient to enable any person skilled in the art to which the invention pertains to make and use the invention.

Title 35, United States Code, Section 120 (*infra*, p. 1a) provides that an applicant for patent shall be given the benefit of an earlier filed copending application if it contains specific reference to the earlier filed copending application.

Title 35, United States Code, Section 145 (*infra*, p. 1a) provides "An applicant dissatisfied with the decision of the Board of Appeals . . ." of the United States Patent Office may ". . . have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia . . .".

Title 35, United States Code, Section 261, (*infra*, p. 2a) provides ". . . patents shall have the attributes of personal property . . ."

Title 35, United States Code, Section 282 (*infra*, p. 2a) provides in pertinent part that "A patent shall be presumed valid."

The Fifth Amendment to the Constitution of the United States (*infra*, p. 2a) provides that no person shall be deprived of property without due process of law.

This case presents the following questions dealing with the interpretation and application of the Statutes and of the Fifth Amendment:

1. Where the specific meaning of terms used in a patent specification cast in organic chemical nomenclature, which is a written international code, has been clearly demonstrated by those skilled in the art as a matter of fact in the District Court and the District Court so found, is it proper for the Court of Appeals

to rule that the specification is insufficient as a matter of law where no error by the District Court is shown?

2. Is the question of the sufficiency of a patent specification a question of law open to the Court of Appeals precisely as it was open to the trial court, so that the Court of Appeals may set aside the judgment of the District Court without pointing out where the District Court was clearly erroneous as required by Rule 52(a) of the Rules of Civil Procedure?

3. In a *de novo* action under 35 United States Code, Section 145, to review an administrative ruling made *ex parte* by the Patent Office on an applicant's right to a patent, where the District Court heard explanatory evidence by those skilled in the art as a basis for ruling in favor of the applicant, is the reversal of the District Court judgment in the absence of any finding of any error on its part a deprivation of the applicant for patent of property without due process of law?

## STATUTES INVOLVED

The statutory provisions involved are Section 112, Section 120, Section 145, Section 261 and Section 282 of Title 35, United States Code, and also the Fifth Amendment to the Constitution, all being printed in Appendix A, *infra*, p. 1a.

## STATEMENT

The history of the case is accurately stated in detail in the dissenting opinion of Judge Danaher, of the Circuit Court of Appeals, *infra*, p. 22a.

On March 13, 1951, Frederick C. Bersworth filed a certain patent application in the United States Patent Office, Serial No. 215,380, entitled, "Hydroxy Derivatives of Alkylene Polyamines". This application was a continuation-in-part of an earlier application, Serial No. 39,377, filed July 17, 1948, which in turn was a

continuation-in-part of an application, Serial No. 657,893, filed March 28, 1946, which issued as United States Patent 2,524,218, October 3, 1950. Each application referred to its predecessor.

Ultimately in the Patent Office claims of application Serial No. 215,380 were deemed to define an invention, but the entire application was finally rejected on the ground that the description of the invention in Bersworth's own United States Patents 2,428,353 and 2,413,856 was a bar to the issuance of the claims, despite the fact they were copending with Bersworth's United States Patent 2,524,218.

The decision of the Board of Appeals was rendered February 18, 1954; it denied rehearing March 31, 1954, and again April 12, 1954.

Petitioners then filed suit April 19, 1954 against the Commissioner of Patents in the United States District Court for the District of Columbia. Jurisdiction of the District Court was invoked under United States Code, Title 35, Section 145.

At trial the Patent Office specifically withdrew all objections to the allowance of claims in the application and rested the question of allowability on the issue of whether Bersworth was entitled to the benefit of the filing date of his United States Patent 2,524,218 so that his earlier patents could not stand as a bar (R. 36—and see District Judge Wilkin's comment in his opinion, *infra*, p. 11a).

The District Court, based on its hearing of factual testimony, found that the application, Serial No. 215,380, was entitled to the filing date of United States Patent 2,524,218 because it was copending with it in accordance with 35 U.S.C. 120 and, accordingly, au-

thorized the Commissioner of Patents to issue the patent, *infra*, p. 19a.

The Commissioner of Patents thereupon appealed to the Court of Appeals, contrary to the express practice described in *Hoover Company* v. *Coe, Commissioner of Patents*, 325 U. S. 79, 88 (1945). Hearing was held March 22, 1957. Decision was rendered by the Court of Appeals January 9, 1958 with two judges voting to reverse the District Court with no finding of error of fact on its part; one judge in a dissenting opinion urged that the decision of the majority was contrary to law.

## REASONS FOR GRANTING THE WRIT

The questions stated are of fundamental importance in the sound development of administrative law in the United States. The fact that they happen to be cast in a context involving the Patent Office is merely incidental. The legal issue fundamentally goes back to the question of what weight should be accorded to the action of an administrative agency.

The Patent Office includes within its structure a large number of Examiners who are individual human beings of various levels of experience—see the Annual Report of the Commissioner of Patents for the Fiscal Year 1957, *infra*, p. 3a. The ultimate judgment of the Patent Office, therefore, is that of an individual tempered by the level of experience of the Examiner, his individual philosophy, and, conceivably, even his prejudices, while acting on matters before him *ex parte*. It is wrong, therefore, to erect in our administrative law a facade of infallibility before an agency, which assumes a uniformity of judgment and practice, and justifying it with the trite expression, in the case of the

Patent Office, that it is a technical agency preeminently qualified and its actions must be accorded a presumption of a high degree of correctness.

The Statute, 35 United States Code, Section 282, merely accords to an issued patent a simple presumption of validity. It is incongruous, therefore, to accord to the action of the Examiner of a patent application anything more than an ordinary presumption of correctness.

The lack of realism in the assertion that the Patent Office is "preeminently qualified" to judge technical matters of this character (*Gold et al* v. *Gold*, 237 Fed. 84, 86 (CCA 7, 1916) may be evaluated in the light of the fact that a large proportion of the Patent Office examining staff has had less than two years of experience in the examination of patent applications. Annual Report of the Commissioner of Patents, *supra*, p. 6.

The presumption of correctness in the *ex parte* action of the administrative agency should be coterminous with the presumption of validity defined in the statute. (*Harmon* v. *Brucker*, — U.S. —, 2 L. Ed. 2d 503; 78 S. Ct. — (1958)).

**1. The only standard for measuring the adequacy of a patent specification is that given in 35 United States Code, Section 112, namely, that it be in terms such as "... to enable any person skilled in the art to which it pertains ..." to make and use the same.**

The language of any given art may be more or less technical, but it is established that in the art of chemistry a special international code has been created for describing structure of compounds. Unless that language can be accepted and given its full factual

significance, the chemist who filed a patent application addressed to chemists, which was full and complete, may lose his right to a patent simply because an inadequately trained administrative officer may not appreciate its significance.

This Court long ago pointed out that any description of the invention sufficient to apprise those skilled in the art in the language of the art of the definite features of the invention is sufficient. *Carnegie Steel Company Ltd.* v. *Cambria Iron Company*, 185 U.S. 403, 437 (1902) and a consistent sequence of cases to date.

The description of the invention, therefore, must be measured first in terms of what it says to those skilled in the art as a question of fact and then, second, the quantum of what it says to those to whom it is addressed may be measured to determine its sufficiency. It is submitted, therefore, that if one skilled in the art reading a patent specification is apprised of how to carry out the invention as a matter of fact, the conclusion of law must be that the specification is adequate. This is because,

> "The specification of the patent is not addressed to lawyers or to the public generally, but to the manufacturers . . .; and any description which is sufficient to apprise them in the language of the art . . . is sufficient . . ."

*Carnegie Steel Company, Ltd.* v. *Cambria Iron Company*, 185 U.S. 403, 437 (1902); *Eibel Process Company* v. *Minnesota & Ontario Paper Company*, 261 U.S. 43, 65, 66 (1923).

**2. The basic function of the trial court is to find the facts and in an action under 35 United States Code, Section 145, the record before the Patent Office is amplified with additional facts.**

In *Graver Tank & Manufacturing Company, Inc., et al. v. Linde Air Products Company*, 336 U.S. 271, 274, 275 (1949), this Court stated—

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.'
>
> "'To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations."
>
> ". . . He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues."
>
> ". . . the facts as found with respect to . . . warrant a conclusion here that as a matter of law those statutory requirements have been met."

The trial court in this case heard witnesses, found facts, wrote a careful and succinct memorandum, and concluded that the specification was sufficient. The Court of Appeals reversed the decision without indicating wherein the trial court was clearly erroneous, or indeed whether it was in error at all.

**3. A patent is a property right and denial of the right to patent in the face of statutory procedures of 35 U.S.C. 120 and 145 is a deprivation of property without due process.**

It is most unlikely that the questions raised in this petition will be raised in any other Circuit for review by any other Court of Appeals. The Commissioner of Patents in his official capacity accepts service in suits under United States Code, Title 35, Section 145, only in the District of Columbia. Accordingly, the minimum which should be expected for the benefit of the public is a uniformity of application of the statute governing issuance of patents by the Court of Appeals for the District of Columbia, because there is no way of obtaining a review of these questions except as this Court may decide to review them.

On the matter of consistency of judicial review of an administrative action, there is available for contrast within this circuit a contemporaneous case, *Stradar* v. *Watson*, 244 F. 2d 737 (U. S. Ct. App. D.C., 1957), in which the issue was the quantum of proof required on the question of disclosure necessary to reverse the Patent Office on the issue of invention. In that opinion, rendered on May 13, 1957 while the instant case was pending before it, the Court of Appeals had the following to say:

> "This proof, which will be noticed later in this opinion, was not contradicted and contained information which was not presented to the Patent Office. That being true, the District Court was not controlled by the presumption of correctness which attaches to a Patent Office action, but was free to reach its own conclusion on the basis of the fuller information which was before it."

In contrast thereto in this case, on January 9, 1958, the Court of Appeals had the following to say:

> ". . . On this appeal the Patent Office does not question, and we do not question, any of the testimony of appellees' witnesses. But we answer the question of law in the negative. . . ."

To the extent, therefore, that a different combination of Judges may be considered a different court, it is possible to find a conflict within this circuit. Indeed, such conflict is shown by the dissenting opinion of Judge Danaher wherein he states:

> "The philosophy permeating the majority opinion basically is one of nullification of the remedy provided by Congress, a result here reached (1) by according to the Patent Office the equivalent of a conclusive presumption of correctness; and (2) by holding that sufficiency of disclosure raises a question of law. . . ." (*infra*, p. 22a)

It would appear, therefore, that simply in the interest of obtaining some degree of consistency of judicial action in cases of this character, review by this Court is in order.

In the face of statutory procedure requiring that an applicant for a patent be given the benefit of the filing date of an earlier copending application, 35 U.S.C. 120, and further procedure expressly permitting explanation of a specification by means of testimony of those skilled in the art in a trial *de novo*, 35 U.S.C. 145, reversal of the District Court here was a clear case of deprivation of property by denial of clear statutory rights, and a violation of the due process provision of the Fifth Amendment.

Patent property is secured by *ex parte* procedure in the Patent Office. 35 U.S.C. 261.

The Court of Appeals by its ruling would convert the *ex parte* determinations of that administrative agency into absolute pronouncements. This cancellation of the remedy provided by 35 U.S.C. 145 is a deprivation of property without due process which requires review by this Court.

## CONCLUSION

It is submitted that the reasons stated above clearly demonstrate that a writ of certiorari should be granted.

Respectfully submitted,

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April, 1958

# APPE

# NDIX

## APPENDIX

35 USC § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 USC § 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 USC § 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United

States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

35 U.S.C. § 261. Ownership; Assignment

Subject to the provisions of this title, patents shall have the attributes of personal property . . . .

35 *USC* § 282

A patent shall be presumed valid . . . .

28 USC § 1254

(1 By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree.

Amend. 5

CONSTITUTION

Amendment V—Due Process

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life,

liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

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## ANNUAL REPORT OF THE COMMISSIONER OF PATENTS

### Fiscal Year 1957

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### PERSONNEL

#### Recruitment and Retention of Employees

In order to understand the situation in regard to examiner personnel during fiscal 1957, it is necessary to consider recruitment and retention conditions as they have existed in a number of prior years. The period from 1947 through 1949 is similar to the present period in that a large number of examiners were added to the staff in an effort to overcome the serious backlog of those years. Of the 501 examiners added in this period of rapid expansion, only 138, or 27.5 percent, are still employed in the Patent Office. During the period from 1950 through 1954, the examining corps was reduced in size because of minimum recruitment activities and heavy losses of examiners. During this 5-year period, 313 examiners were employed while 524 were separated. Of these 313 examiners hired during the 1950-54 period, only 70, or 22.3 percent were still employed in the Patent Office on June 30, 1957.

At the end of fiscal 1957, the Patent Office staff totaled 2,283 employees as compared to 2,047 at the beginning of the fiscal year. The staff included 1,126 patent and classification examiner assistants—an increase over the prior year of 165. Examiner strength in fiscal years 1956 and 1957 was increased by a total of 453 assistants, this being made possible by enlarged appropriations and increased recruitment. To achieve this, while at the same time replacing

examiners who left the Office during this 2-year period, 795 new examiners were employed.

During fiscal 1957, 182 examiners were employed during the first 11 months, but this resulted in a net gain of only one examiner, due to the heavy turnover. The net gain of 165 for the year was the result of hiring during June 1957. Efforts are being made to reduce the turnover by improving the grade structure by justified adjustments.

**Training**

The hiring of many new patent examiners required a great deal of training activity to introduce them to the Patent Law and Patent Office practice and procedure. The initial part of this training was accomplished primarily by classroom instruction of each new group for 2 weeks. This was followed by assignment of the new examiners to examining divisions where they received instruction on the job under the direct supervision of their primary examiners. Advanced lectures were given to the newer examiners after they had acquired some examining experience, and these included discussion of patent practice and law. During fiscal 1957, 355 new patent examiners were given the initial 2 weeks' training in 15 separate groups. Between October 2, 1956, and May 14, 1957, 222 examiners were given the advanced lecture training program in weekly lectures of 1 hour a week.

The initial training through classroom instruction has proved successful both in rapid development of the new men as examiners, and in the beneficial experience acquired by the older men serving as instructors.

* * * * * * * * * *

Appeal No. 335-58 Paper No. 19

Hearing: January 26, 1954.

In the United States Patent Office

Before the Board of Appeals

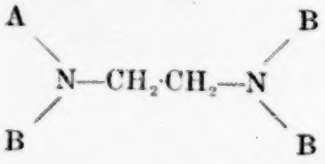
Ex Parte Frederick C. Belsworth

Application for Patent filed March 13, 1951, Serial No. 215,380. Hydroxy Derivatives of Alkylene Polyamines.

This is an appeal from the action of the Examiner finally rejecting claims 1, 2, 3 and 4, all the claims in the application.

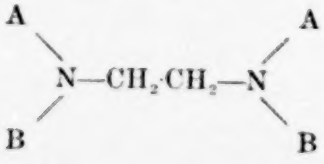
Claims 1 and 2 are representative.

1. The compound conforming to the formula—




wherein A is a substituent group selected from the group consisting of ethanol and propanol and B is an acetic acid substituent group.

2. The compound conforming to the formula—




wherein A is a substituent group selected from the group consisting of ethanol and propanol and B is an acetic acid substituent group.

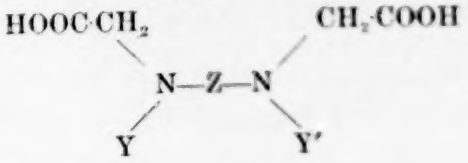
The references relied upon are:

Bersworth—2,413,856, Jan. 7, 1947.

Bersworth—2,428,353, Oct. 7, 1947.

The claims on appeal are to chelating agents which are sufficiently described by the copied claims.

Claims 1, 2, 3 and 4 stand rejected as unpatentable over either of the Bersworth patents Nos. 2,413,856 and 2,428,353. These patents disclose compounds of the general formula




where Z is alkylene and Y and Y' are alkylol groups. In 2,428,353 the alkylene is disclosed as ethylene, for example, and the alkylol substituent may be ethanol. In column 3, lines 26 and 27 ethylene diamine N,N'-triacetic acid N'-ethanol is disclosed by name. This is one of the compounds covered by the presently appealed claim 1.

There appears to be no dispute on the fact that these patents disclose compounds which anticipate the appealed claims. The argument for patentability is that these patents are not proper references by virtue of the fact that appellant had pending before the Patent Office this subject matter prior to the effective dates of these patents. Appellant traces a chain of continuity back to the parent patent 2,407,645 filed June 21, 1943. Appellant states that the filing of applications Serial Nos. 39,377 and 39,378, which covered the genus and species of the instant application prior to issue of Patent No. 2,524,218, completely negatives abandonment of the invention now claimed in the present application, which is a continuation of Serial No. 39,377.

The alleged chain of continuity depends *inter alia* on Patent No. 2,524,218, which the Examiner has found not to have a disclosure adequate to support the present claims. The Examiner has referred to *In re* Stoll et al, 603 O. G. 378; 1947 C. D. 392; 34 C. C. P. A. 1058; 161 F. (2d) 241; 72 USPQ 440 to support his proposition that there is a critical difference between the disclosure required to support claims and that necessary for employment as a reference. The pertinent disclosure in 2,524,218 relied on for continuity is found in column 1, lines 25 to 46 inclusive. This portion of the patent reproduces a formula with lettered substituents. By selecting certain values and substituents within this disclosure, such as when M is zero, A is a hydrocarbon containing at least two carbon atoms, a hydrogen of which is replaced by OR wherein R is hydrogen, then the compounds now claimed would be reproduced. The disclosure in Patent 2,524,218 does not specifically disclose any of the compounds now claimed hence by the usual standards would not support such claims. Since adequate support in this patent would be necessary for appellant to overcome the effect of the disclosures in Patent 2,413,856 and 2,428,353 as prior art, it follows that these patents constitute proper references and that the rejection of the Examiner thereon must be sustained. The affidavit of Arthur E. Martell has been reviewed but does not appear to have any bearing upon this ground of rejection.

The decision of the Examiner is affirmed.

E. W. Geniesse,
*Examiner in Chief,*

N. A. Asp,
*Examiner-in-Chief,*

Arthur B. Miller,
*Examiner-in-Chief (Acting),*
*Board of Appeals.*

. . . . . .

Appeal No. 335-58 Paper No. 22

In the United States Patent Office

Before the Board of Appeals

Ex Parte Frederick C. Bersworth

Application for Patent filed March 13, 1951, Serial No. 215,380. Hydroxy Derivatives of Alkylene Polyamines.

On Petition for Reconsideration

A petition is presented requesting a rehearing and a reconsideration of our decision of February 18, 1954 wherein we affirmed the Examiner in refusing to allow claims 1, 2, 3 and 4. Our crowded docket does not ordinarily permit rehearings and we do not grant them unless there are special circumstances to warrant it. We see no basis for a rehearing in this case, hence the petition will be treated as one for reconsideration.

The petition under point 1 takes issue with our finding that U. S. Patent 2,524,218 does not specifically disclose any of the compounds now claimed and consequently does not provide proper support for such claims. In a lengthy petition accompanied by affidavits appellant seeks to show that with the broad formula of this patent before him and the possible substituents named one would be *compelled* to arrive at the compound now claimed. This premise seems based on the assumption that one would start substituting the simplest possible radicals in the formula and in doing this would inevitably come up with the compound of the present claims. Separate affidavits by Arthur E. Martell and by Thomas H. Whaley have been submitted in an effort to substantiate this contention. The Martell affidavit is summarized by appellant as establishing that a scientist reads the formula "to find diethanolethylenediaminediacetic acid in it as the take-off point for elaboration". The Whaley affidavit was submitted as evidence that an "attorney coming to the disclosure 'cold' in five minutes wrote five formulas" therefrom four of which

were specific and one being diethanolethylenediaminediacetic acid.

The experiments represented by the affidavit may be of interest as mental tests applied to the problem of what likely compounds are embraced by the broad formula in question. Possibly the same tests could be applied to German Patent 642,244. As stated by the Examiner in his Answer of February 13, 1953, Paper No. 12, page 2

> If the disclosure of patent No. 2,524,218 is sufficient to support the claims, then by the same reasoning the German patent No. 642,244 anticipates the claims, since this patent has a similar generic disclosure of the subject matter and a specific illustration of the triethanol derivative, applicant covering the other two possible combinations the mono-and diethanol derivatives.

It should be obvious that these tests and affidavits cannot serve to supply any specific disclosure of the compounds now claimed to Patent No. 2,524,218. Lacking such disclosure we are unable to see how the patent can form proper support for the present claims. The Stoll et al decision appears controlling here. With the alleged chain of continuity broken, Patents 2,413,856 and 2,428,353 become statutory bars. It is therefore unnecessary to consider the question of dedication, point 3 page 13 of the petition. Points 2, 4 and 5 of the petition are merely statements of the obvious such as "Claims of a patent must have adequate support in the specification."

The petition has been considered but is denied in respect to making any change in our decision.

E. W. Geniesse,
*Examiner-in-Chief,*

N. A. Asp,
*Examiner-in-Chief,*

Arthur B. Miller,
*Examiner-in-Chief (Acting),*
*Board of Appeals.*

* * * * * * * * * *

Appeal No. 335-58 Paper No. 24

In the United States Patent Office

Before the Board of Appeals

Ex Parte Frederick C. Bersworth

Application for Patent filed March 13, 1951, Serial No. 215,389. Hydroxy Derivatives of Alkylene Polyamines.

Appellant has filed, on April 5, 1954, a further request for reconsideration of the Board's decision of February 18, 1954.

Since this request comes more than thirty (30) days from the date of the decision, the Board must refuse to act thereon, according to Rule 197 (January 1, 1953) amended March 3, 1954, which states that

> Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Appeals so states.

The file is therefore returned to the Primary Examiner.

By Order of the Board of Appeals.

Nicholas Hahn,
*Administrative Officer.*

* * * * * * * * * *

United States District Court for the
District of Columbia

Civil Action No. 1637-54

FREDERICK C. BERSWORTH AND THE DOW CHEMICAL COMPANY, PLAINTIFFS

*v.*

ROBERT C. WATSON, COMMISSIONER OF PATENTS, DEFENDANT

*Memorandum by the Court*

Filed June 7, 1956. Harry M. Hull, Clerk.

WILKIN, *District Judge (by Designation)*:

This action was brought under the provisions of Section 145 of Title 35, United States Code. The plaintiffs seek a judgment authorizing the defendant, Commissioner of Patents, to grant plaintiffs letters patent upon certain claims of plaintiffs' application, Serial No. 215,380, filed March 13, 1951, entitled "Hydroxy Derivatives of Alkylene Polyamines." The complaint states that the claims are numbered 1 through 4, but since plaintiffs entered a voluntary dismissal, without prejudice, of claims 1 and 3, only claims 2 and 4 are before the court.

The specification of the application indicates that the subject matter relates to hydroxy derivatives of alkylene polyamines, a group or class of organic compounds having wide utility in the chemical arts, and particularly as sequestering agents (chelating agents) in aqueous solutions for the metal ions invariably present therein. It is not necessary to evaluate the details of the chemistry of the compounds covered by the claim, because the Patent Office has conceded that the claim defines a patentable invention.

The fundamental issue in the case is:

Does applicant's United States Patent 2,524,218 issued October 3, 1950 on an application filed March 28, 1946,

include disclosure of subject matter of the claim before the Court sufficient to support continuity of that subject matter before the Patent Office?

The trial proceeded on the single issue of whether the applicant had sufficiently disclosed his subject matter in the parent Patent 2,524,218 to support continuity of subject matter in the application now before the Court. The Patent Office tribunals held that the application resulting in Patent No. 2,524,218 did not have a disclosure adequate to support the present claims.

The doctrine of continuity holds that a second application should be considered a continuation of a first application and entitled to the benefit of the filing date of the first application, where a patent is still sought for the substance of the invention as originally claimed. In order that the doctrine be applicable, it is necessary that the description in both applications be sufficient to support the claims. *Godrey* v. *Eames*, 68 U. S. 317; *Duryea* v. *Rice*, 28 App. D. C. 423.

It seemed to be conceded by the parties that plaintiffs' case would stand or fall on the question whether the prior application contained a disclosure sufficient to support claims 2 and 4 of the application before the Court.

The disclosure of Patent 2,524,218 is in a concentrated form which, plaintiffs assert, sets forth specifically the formula for the elected claim of the application before the Court. Column 1, lines 25-46, in the language of the chemist, and in the form required by the Patent Office, gives the detailed information defining the metes and bounds of that disclosure. The defendant conceded that if the claims at issue were directed to the general formulation, the doctrine of continuity would permit plaintiffs to rely upon the earlier patent for their date of invention, but defendant contended that the claims at issue here are not a general formulation, but instead are specific to two distinct com-

pounds, and that such compounds were not disclosed in the earlier application.

Plaintiffs, on the other hand, contend that the claim before the Court was directly divided out of claim 1 of the earlier application. They admit that the formula presented disclosure of possibly a limitless number of other compounds, but they insist that that fact does not prevent the plaintiffs' contention that the applicant had a clear conception of the invention claimed here. They insist that the original formula embraced the specific concept presented in this case.

The statutory requirement is that the disclosure be cast "in such full, clear concise and exact terms as to enable any person skilled in the art to which it pertains * * * to make and use the same." It was conceded that the test would be what the disclosure meant to "any person skilled in the art." The plaintiffs, therefore, called expert witnesses and members of a class of advanced students of chemistry to support their contention that the specific directions given in the chemical formula, and the explanatory language used to define the various symbols set out in the general formula, would lead the expert to the specific compounds defined in the claims at issue. The experts who testified and the members of the chemistry class, who had been given the problem as a class exercise, all stated that the specific compounds of the claims at issue were derivable from the general formula.

The evidence before this Court was clear and convincing that the symbols, when interpreted in the light of the specifications, did lead those experienced in this field of chemistry and advanced students of such chemistry to the embodiment claimed by the plaintiffs. The testimony of the experts was clear and convincing that the language of the original application, including the chemical symbols, did lead directly to the composition for which the plaintiffs seek a patent monopoly.

The defendant offered no testimony, but relied upon the material contained in the file wrapper and the opinions of the Examiner and Board of Appeals.

The Court is constrained to find in favor of the plaintiffs because the evidence sustains the plaintiffs' contention.

Findings, conclusions and order may be prepared and submitted by counsel for plaintiff.

R. N. WILKIN,
*U. S. District Judge.*

WASHINGTON, D. C., June 6, 1956.

In the United States District Court
for the District of Columbia

Civil Action No. 1637-54

FREDERICK C. BERSWORTH AND THE DOW CHEMICAL COMPANY, PLAINTIFFS

*vs.*

ROBERT C. WATSON, COMMISSIONER OF PATENTS, DEFENDANT

*Findings of fact*

Filed June 29, 1956. Harry M. Hull, Clerk.

1. This is a Civil Action brought under the provisions of 35 U. S. C. 145 in which the plaintiffs, Frederick C. Bersworth, the inventor and The Dow Chemical Co., the assignee, seek a judgment authorizing the Commissioner of Patents to issue a patent upon United States Patent Application S. N. 215,380 filed March 13, 1951 for "Hydroxy Derivatives of Alkylene Polyamines".

2. The Dow Chemical Company, a Delaware Corporation, having its offices and principal place of business in Midland, Michigan, having acquired the entire right, title, and interest in and to the patent application, was made a party

coplaintiff pursuant to an Order of the Court dated February 21, 1955.

3. United States Patent Application S. N. 215,380 was filed March 13, 1951 specifically as a continuation-in-part of United States Patent Application S. N. 39,377, abandoned March 21, 1951, and was copending therewith.

4. United States Patent Application S. N. 39,377 was filed July 17, 1948 as a continuation-in-part of United States Patent 2,524,218 which issued October 3, 1950 on an application S. N. 657,893, filed March 28, 1946, and was copending therewith.

5. United States Patent 2,524,218, was copending with United States Patent 2,413,856 issued January 7, 1947, on application S. N. 495,207 filed July 17, 1943, and also was copending with United States Patent 2,428,353, issued October 7, 1947, on application S. N. 491,670 filed June 21, 1943, and incorporates the disclosure of said patents into its specification.

6. The Patent Office in the Board of Appeals' Decision of February 18, 1954, refused to allow the claims of application S. N. 215,380 as being anticipated by United States Patent 2,428,353 and 2,413,856 on the ground that the disclosure of United States Patent 2,524,218 was insufficient to maintain continuity of the subject matter before the Patent Office to give the application S. N. 215,380 the benefit of the filing date of United States Patent 2,407,645.

7. United States Patents 2,407,645 and 2,428,353, having been filed simultaneously by the same inventor and having been cross referenced effectively make one large disclosure.

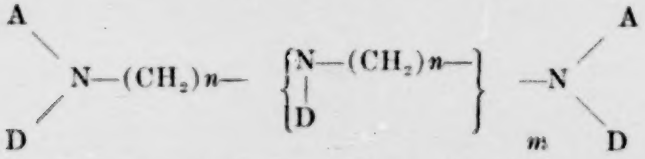
8. United States Patent 2,413,856 issued January 7, 1947 on application S. N. 495,207 filed July 17, 1943, was copending with United States Patents 2,407,645 and 2,428,353.

9. The disclosure of United States Patent 2,524,218 includes a clear description of the concept of the subject

matter of the application before the Court, and refers to United States Patent 2,407,645, which in turn refers to the application S. N. 491,670 which became United States Patent 2,428,353.

10. A portion of the disclosure of United States Patent 2,524,218 is in a concentrated form, commonly used in specifications and accepted by the Patent Office, and includes the following passage at column 1, lines 25-46:

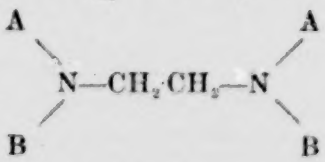
> The alkylene polyamine derivatives of the present invention are represented by the following formula:



> wherein n is either 2 or 3 and m is either zero or a positive integer and wherein D is a member of the group consisting of $-CH_2COOH$, $-CH_2CH_2COOH$, and their alkali metal salts, and wherein A is a hydrocarbon group containing at least two carbon atoms and having not more than two hydrogen atoms replaced by a member of the group consisting of $-(CH_2)_2COOR$, $-(CH_2)_2COOM$, $-SO_3H$, $-SO_3M$, $-OR$ and $OR'OR$ wherein R is alkyl or hydrogen, M is an alkali metal, and R' is alkylene, said groups being spaced at least two carbon atoms from the nitrogen atoms.

11. Claim 2 of United States Patent application S. N. 215,380 was the species elected for prosecution before the Patent Office and it reads as follows:

> 2. The compound conforming to the formula



> wherein A is a substituent group selected from the group consisting of ethanol and propanol and B is an acetic acid substituent group.

Claim 4 defines the basic metal salts of the compounds of Claim 2.

12. The evidence before this Court was clear and convincing that the symbols set out in the formula as in finding 10, when interpreted in the light of the specifications, did lead those experienced in this field of chemistry and advanced students of such chemistry to the embodiment claimed by the plaintiffs. The testimony of the experts was clear and convincing that the language of the original application, including the chemical symbols, did lead directly to the composition for which the plaintiffs seek a patent monopoly.

13. Claim 2 of United States Patent Application S. N. 215,380 is specifically supported by the disclosure of United States Patent 2,524,218. In fact, Claim 2 of S. N. 215,380 was directly derived from Claim 1 of United States Patent 2,524,218 as filed.

14. The Patent Office having conceded that the subject matter of United States Patent Application S. N. 215,380 is inventive, claims 2 and 4 define inventive subject matter.

15. Claims 1 and 3, directed to nonelected subject matter, were withdrawn from consideration by stipulation of the parties.

*Conclusions of Law*

1. The application S. N. 215,380 was a proper continuation-in-part of S. N. 39,377.

2. Application S. N. 39,377 was a proper continuation-in-part of United States Patent 2,524,218.

3. Application S. N. 215,380 is accordingly entitled to the benefit of the filing date of United States Patent 2,524,218.

4. Certain generic disclosure of United States Patent 2,524,218 appearing at column 1, lines 25-46, being in the

Markush form, which is a creature of Patent Office practice, is a part of the total disclosure of the Patent and should be considered specific support for those compounds to which the disclosure specifically leads.

5. Claims 2 and 4 are not anticipated by the prior art cited, they are patentable, and patent may issue on the application S. N. 215,380.

6. The doctrine of continuity of subject matter before the Patent Office requires that United States Patent application S. N. 215,380, which defines a concept initially disclosed in United States Patents 2,407,645 and 2,428,353, and which was carried in substance consistently through United States Patent 2,524,218 and United States Patent application S. N. 39,377, be accorded the benefit of the early filing date namely, June 21, 1943. Godfrey v. Eames, 68 U. S. 317.

R. N. Wilkin,
R. N. Wilkin,
*U. S. District Judge.*

June 29, 1956.

In the United States District Court
for the District of Columbia

Civil Action No. 1637-'54

Frederick C. Bersworth and the Dow Chemical Company, plaintiffs

*v.*

Robert C. Watson, Commissioner of Patents, defendant

*Order*

Filed June 29, 1956. Harry M. Hull, Clerk.

This action came on to be heard at the last term of Court and thereupon, upon consideration thereof; it is this 29th day of June, 1956,

Ordered, adjudged and decreed that:

The Commissioner of Patents is authorized to issue a patent on application S. N. 215,380 containing claims 2 and 4.

The Complaint, insofar as it relates to claims 1 and 3 representing non-elected subject matter, is dismissed without prejudice.

The expenses incurred herein shall be borne by the plaintiffs.

R. N. Wilkin,

ROBERT N. WILKIN,
*U. S. District Judge.*

* * * * * * * * * *

Before EDGERTON, Chief Judge, and BAZELON and DANAHER, Circuit Judges.

EDGERTON, Chief Judge.

This is a suit under 35 U.S.C. § 145, 66 Stat. 803 § 1, for a patent on certain claims of an opplication filed in the Patent Office in 1951. The Patent Office rejected the claims as anticipated by certain references, namely two patents issued in 1947. The District Court overruled the Patent Office and the Commissioner of Patents appeals.

In 1946 appellees filed an application, Serial No. 657,893, which became Patent No. 2,524,218. If the disclosure in that application would have supported claims like those now in suit, had they been made then, the doctrine of "continuity" gives these claims the benefit of the filing date of that application and so entitles them to priority over the references. The Patent Office tribunals ruled that the 1946 disclosure would not have supported claims like these. The District Court held the contrary.

The claims are for a chemical compound described by specific formula, and for the basic metal salts of this com-

pound. The 1946 application did not disclose the specific formula of this compound. According to undisputed testimony in the District Court, a general formula disclosed by the 1946 application "encompassed within [its] scope * * * a large number", possibly thousands, of compounds, including the one now specifically claimed; "a small number of known, but many unknown" compounds; chemists can "derive" the specific formula now claimed, and many others, from the general formula; "You derive the compound [now claimed] by assigning certain values to the *m* variables set forth in the general formula" disclosed in 1946, but "there are many other compounds that would be derived in the same way * * *." A witness for appellees who testified, on direct examination, that the 1946 "formula, with the explanatory disclosure, specifically dictates the formula" now claimed testified on cross-examination that "One is led to other compounds as well" and that he "had a definite goal in mind" when he picked a particular "substituent".[1]

[1] The difference between the Patent Office and the District Court, and the issue before us, is not factual. As the Commissioner of Patents says in his brief, "There is little, if any disagreement as to the salient pertinent facts of this case." He does not deny that the appellees are entitled to a patent if their 1951 claims are entitled to priority over the 1947 references. The appellees do not contend that they are entitled to a patent if their claims are not entitled to priority over those references. The

[1] Since the Patent Office tribunals said nothing to the contrary, although the Commissioner's brief suggests a doubt, we assume in appellees' favor without deciding that the testimony meant the 1946 disclosure not only enabled chemists to *write the formula* now claimed but also enabled them to *make the compound* now claimed; despite the fact that it is not clear, to us non-chemists, that either the testimony or the District Court's findings meant this. One of appellees' witnesses testified without dispute that there "may be years of research necessary in order to make many" of the specific compounds encompassed within the scope of the general disclosure.

question is not whether an invention has been made. The question is whether the appellees are entitled to claim the invention. The answer turns on the relation between the words of the 1946 application and the words of the 1951 claims. And "the words of a patent or a patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts. Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 50 S. Ct. 9, 74 L. Ed. 147, 3 USPQ 40 * * *." Minnesota Mining & Mfg. Co. v. Carborundum Co., 155 F. 2d 746, 749, 69 USPQ 288, 291 (3d Cir.). The 1946 disclosure would or would not have supported claims like the ones now made according to whether such a general disclosure does or does not, in respect to such specific claims, meet the legal requirement that "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such *full, clear, concise and exact terms* as to enable any person skilled in the art to which it pertains * * * to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112, (Emphasis added.). "This is a question of law, open to this court, precisely as it was open to the court below." Minnesota Mining case, supra. On this appeal the Patent Office does not question, and we do not question, any of the testimony of appellees' witnesses. But we answer the question of law in the negative.[2] As [2] a matter of law, an applicant cannot " 'in-

[2] (3) If it were a question of fact the result would be the same. A mere preponderance of evidence, if any, would not justify the District Court in reversing a factual finding of the Patent Office. Con(4)cerning the factual question whether patent claims are inventive, for example, it has long been clear that " 'A mere preponderance of evidence' is not enough to justify reversing the Patent Office and deciding that an applicant is entitled to a patent. ' Abbott v. Coe, 71 App. D.C. 195, 197, 109 F. 2d 449, 451, 43 USPQ 267, 269. Even when, as often happens, the District Court has before it more evidence than the Patent Office had, it remains true that on a factual issue "the Patent Office finding must be

clude and claim a specific thing not originally described, merely because it comes within the scope of the genus before disclosed.' " In re Mraz, 36 App. D.C. 435, 438. An applicant "under the circumstances of this case, cannot preempt the entire field * * * by broadly teaching that useful results may be obtained by mixtures and combinations of a broad general group of materials without specifically naming such material * * * or in some other manner pointing out his invention as is required by statute * * *." In re Collins, 75 F. 2d 1000, 1002, 25 USPQ 38, 41 (C.C.P.A.). Minnesota Mining case supra.

Reversed.

DANAHER, Circuit Judge, dissenting.

The philosophy permeating the majority opinion basically is one of nullification of the remedy provided by Congress, a result here reached (1) by according to the Patent Office the equivalent of a conclusive presumption of correctness; and (2) by holding that sufficiency of disclosure raises a question of law. Relegated to zero status is the District Court, with its findings, its conclusions, its memorandum opinion and its judgment. Judge Wilkin heard many witnesses, had the benefit of charts and exhibits, received detailed explanations as to the points in issue and possessed the advantage of colloquy with opposing counsel. The record discloses close and careful attention to the many

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accepted if it is 'consistent with the evidence,' the Patent Office being an expert body pre-eminently qualified to determine questions of this kind." Esso Standard Oil Co. v. Sun Oil Co., 97 U.S. App. D.C. 154, 157, 229 F. 2d 37, 40, 108 USPQ 161, 163. This includes the evidence before the court and the evidence before the Patent Office. On a factual issue the question "is whether all competent evidence, 'new' and 'old', offered to the District Court carries 'thorough conviction' that the Patent Office erred." Minnesota Mining & Mfg. Co. v. Carborundum Co., 155 F. 2d 746, 748, 69 USPQ (5) 288, 291 (3d Cir.). If the District Court overrules a factual finding that is consistent with the evidence, the court is clearly wrong and we must reverse. In the present case, it appears to us that the Patent Office finding is not only consistent with the evidence but does not conflict with any of the evidence.

aspects of the case brought under 35 U.S.C. § 145 which permits a dissatisfied applicant to pursue his remedy in the District Court which may adjudge the applicant entitled to receive a patent "*as the facts in the case may appear.*" (Emphasis supplied.)

The majority views here given effect may be found more expansively set forth in Judge Edgerton's dissenting opinion in Carbide & Carbon Chemicals Corporation v. Coe.[1] Interestingly enough, contrary to the findings authorizing a patent in the instant case, the trial judge there found no invention, and Judge Edgerton writing in support of his ruling, said: " 'Under the rule settled in this jurisdiction, while we are not absolutely bound by a chancellor's findings of fact, we are not to disturb them on appeal unless upon an examination of the evidence they are clearly wrong.' " 69 App. D.C. at 382, 102 F. 2d at 246, 40 USPQ at 151. We recently pointed out that under governing case law and the Federal Rules, even as to patent cases, "A finding of fact by the District Court, sitting without a jury, may be set aside on appeal only if it is clearly erroneous."[2] We noted that in such situations we are

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[1] 69 App. D.C. 372, 378-383, 102 F. 2d 236, 242-247, 40 USPQ 141, 147-151 (D.C. Cir. 1938); cf. his explanation of the case and his further views in Abbott v. Coe, infra note 3.

[2] Esso Standard Oil Company v. Sun Oil Company, 97 U.S. App. D.C. 154, 156, 229 F. 2d 37, 39, 108 USPQ 161, 163 (D.C. Cir. 1956), cert. denied, 351 U.S. 973, 109 USPQ 517 (1956); and see Graver Mfg. Co. v. Linde Co., 339 U.S. 605, 611, 85 USPQ 328, 331 (1950); in the earlier case, Graver Mfg. Co. v. Linde Co., 336 U.S. 271, 274-75, 80 USPQ 451, 452 (1949), the Court had said:

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. • • • He wrote a careful and succinct opinion and made findings covering all the factual issues."

bound to inquire whether the District Court's findings are clearly erroneous. Here, no effort is made by the majority to demonstrate that Judge Wilkin's findings are "clearly wrong," or "clearly erroneous." They are simply and peremptorily spurned as meaningless and nugatory in the context of the majority's treatment of the problem. I shall later undertake to show that the District Judge, with thorough conviction, arrived at his amply supported findings on the new evidence before him. I fail to see how he could have found otherwise than he did.

I.

Contrary to our recent cases, the majority really are saying even when the District Court has before it evidence the Patent Office did not have, on a question of fact " 'the Patent Office finding must be accepted if it is "consistent with the evidence," the Patent Office being an expert body pre-eminently qualified to determine questions of this kind.' Esso Standard Oil Co. v. Sun Oil Co., 97 U.S. App. D.C. 154, 157, 229 F. 2d 37, 40, 108 USPQ 161, 163." That case did not so rule, I submit, except in situations where the new evidence amounts to a mere preponderance. On the contrary, the opinion pointed out, 97 U.S. App. D.C. at 159, 229 F. 2d at 42, 108 USPQ at 165: "Of course, *if the decision of the Patent Office is not warranted on the evidence before it*, or *if the new evidence reaches the necessary standard*, the District Court *may rule as the totality of the evidence may require.*" (Emphasis mine.)

The majority in support of the status it accords to the Patent Office action cites Minnesota Mining & Mfg. Co. v. Carborundum Co., 155 F. 2d 746, 748, 69 USPQ 288, 291 (3 Cir. 1946). But that case went off on the "mere preponderance" test (compare Eiten v. Lovell Manufacturing Company, 225 F. 2d 844, 848, 106 USPQ 79, 82 (3 Cir. 1955), cert. denied, 350 U.S. 966, 108 USPQ 456 (1956)), and the proof was deemed insufficient to meet the "thorough con-

viction" requirement spelled out in our case of Esso Standard Oil Company v. Sun Oil Company, supra note 2. In this respect, the result in the Minnesota Mining case was simply the converse of our Carbide & Carbon Chemicals case, supra Note 1, where we found invention, thus reversing the District Court. Judge Edgerton explained that the latter opinion "should be understood to mean, not that the usual presumptions of administrative and judicial correctness are inapplicable in suits to obtain a patent, *but that the evidence in that particular case overcame these presumptions.*"[3] (Emphasis supplied.)

Therefore, I would suppose the true rule to be that above quoted from the Esso Standard Oil Company case, supra. So applied, the test was overwhelmingly met by the evidence here, in character and amount carrying thorough conviction. The answers on cross examination quoted by the majority had largely to do with the non-elected subject matter in another divisional application, indeed the applicant's Claim 1 was, by express stipulation of the parties, withdrawn from this case. Affirmatively the expert referred to by the majority made it clear he was answering merely in terms of the "theoretical." He testified unequivocally that the compounds to be derived from the claims in issue were the most practical and the most obvious, and that one skilled in the art would arrive at these compounds. His testimony in terms of the realities was abundantly supported. Surely the appellant could not plausibly argue that to have sufficient disclosure the claimed compounds must be the only ones which a chemist would derive; otherwise every application would have to be so specific that no alternative compounds would be possible. Nor did the Patent Office so argue, for its counsel surely recognized the doctrine of continuity, and he knew any such result

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[3] Abbott v. Coe, 71 App. D.C. 195, 198, 109 F. 2d 449, 452, 43 USPQ 267, 269 (D.C. Cir. 1939); and see discussion of this point in Standard Oil Development Co. v. Marzall, 86 U.S. App. D.C. 210, 213, 181 F. 2d 280, 283, 84 USPQ 363, 366 (D.C. Cir. 1950).

would render meaningless the statute which permits a prior filing date to be given to a subsequent claim when that claim is disclosed in the prior application. Actually the Patent Office conceded invention as to the subject matter here, indeed various patents were issued, including the references relied upon by the Patent Office. Of course the claim here could not have been allowed in the patents referred to since they claimed different inventions. I fail to understand an assertion of lack of disclosure since the Board of Patent Appeals finds and sets forth the very formula before the court. That is the way the record stood before the new evidence was presented to the District Court upon which its findings are based. It seems to me that the findings not only are not shown to be clearly erroneous, they are clearly right, and the new evidence supporting them reached the "necessary standard," supra. Thus there is here no room for the presumption of correctness, and it should be laid out of the case.

## II.

The majority, to avoid the impact of our Esso rule, conclude erroneously I think, that here is presented a question of law arising from "the words of a patent or a patent application." The majority say the specification shall set forth its disclosure in "full, clear, concise, and exact terms * * *. 35 U.S.C. § 112," and "'This is a question of law * * *.'" But the majority fail and decline to give effect to the statute at precisely the point critical in this case, for the statute is satisfied if disclosure is in such terms "*as to enable any person skilled in the art to which it pertains * * * to make and use the same* * * *." (Emphasis supplied.) Thus, the question was not one of construing the "words" of the application, but whether the disclosure was sufficient to a "person skilled in the art." On that point the evidence of the experts is received by the courts, not as determining the issue, but as affording

proof upon which the trier must pass as to what the application discloses to those skilled in the art.

As Judge Learned Hand wrote long since in Kohn v. Eimer, 265 F. 900, 902 (C. Cir. 1920):

> "Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, the judge should understand what the specifications say."

And see Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 437 (1902), "The specification of the patent is not addressed to lawyers * * *."

Here, the District Judge heard the experts and witnessed their demonstrations. One a professor, had put before his class in organic chemistry the very problem in suit. Student after student took the witness stand and testified to the evolution of the formula for the compounds defined in the claim, and each illustrated its achievement from the specification and the descriptions of the instant claim. Thus, the experts, and even those not yet graduated, demonstrated the sufficiency of the disclosure. The only question of law was that involved in the judgment of a trier who, when he understood the specifications, was bound to accept the responsibility for decision as to sufficiency. I suggest he correctly decided upon findings arrived at with complete conviction that continuity of the subject matter defined by the claim was maintained before the Patent Office at all times here material.

I see here, not a matter of construing language, not a question of law, but one of fact[4] as to what was disclosed to those skilled in the art.

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[4] Cf. Faulkner v. Gibbs, 170 F. 2d 34, 37, 79 USPQ 158, 161 (9 Cir. 1948), aff'd, 338 U.S. 267, 83 USPQ 192 (1949); and see Standard Oil Development Co. v. Marzall, 86 U.S. App. D.C. 210, 181 F. 2d 280, 84 USPQ 363 (D.C. Cir. 1950); White v. E. L.

## III.

The cases my colleagues cite and rely upon may readily be distinguished, I submit. They quote from Minnesota Mining & Mfg. Co., supra, where they necessarily include Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 3 USPQ 40 (1929), as cited by the Third Circuit. The latter case, 280 U.S. at 36, 3 USPQ at 42, limits itself to saying that upon "*undisputed evidence* the question of *infringement* resolves itself in each case into one of law * * *." (Emphasis added); and again, at page 43, 3 USPQ at 45, the Third Circuit decree was reversed because the Court's conclusion was reached "under the controlling weight of the undisputed facts * * *."

As Judge Maris recently wrote: "It may be conceded that the question of construing the claims of a patent is one of law in the sense that, as in the case of other integrated documents, it is a question for the court and not the jury. But the question of infringement involves also questions of fact, such as the nature of the devices alleged to infringe * * *. Thus the finding of infringement is a finding of fact * * *." Vanderveer v. Erie Malleable Iron Co., 238 F. 2d 510, 514, 111 USPQ 292, 295 (3 Cir. 1956) citing, in footnote 14, three cases. Clearly, as the note shows, he is speaking there of Singer Co. v. Cramer, 192 U.S. 265, 275 (1904), as holding infringement presents a question of law only where "*extrinsic evidence* is *not needed to explain terms of art* therein, or to *apply* the *descriptions to* the *subject matter*." (Here the extrinsic evidence was properly received for both purposes.) In that same sense and in the same note, Judge Maris cites the Minnesota Mining & Mfg. Co. case. Thus, not even in the Third Circuit is the latter case relied upon for the proposition here

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Bruce Co., 162 F. 2d 304, 73 USPQ 420 (3 Cir. 1947); and see cases cited, note 19 infra; for the "words" of this application, see the chemical formulation in note 13 infra. How this presents a "question of law" has not been brought home to me.

asserted; indeed the case has never been cited by the Supreme Court nor by any court of appeals but this one, so far as I can see. On the contrary, the rule in the Third Circuit is set forth in White v. E. L. Bruce Co., 162 F. 2d 304, 305, 73 USPQ 420, 421 (3 Cir. 1947), following Hazeltine Corp. v. General Motors Corp., 131 F. 2d 34 (3 Cir. 1942), where at page 37, 55 USPQ 158, 159-160, that court said:

> "Whether a patent shows invention is a question of fact and the findings of the trier of fact upon this issue are not to be disturbed unless clearly erroneous or not supported by substantial evidence. [Citing Keyes v. Grant, 118 U.S. 25 (1886) and several other Supreme Court cases]."

The majority quotes a sentence from In re Mraz, 36 App. D.C. 435 (1911), but the context must be appraised. There, the appellant's original application was rejected since he had claimed a composition consisting of gelatin, glycerin and an "oxygenated solution," but failed to give an example of "oxygenated solution." Thus there was insufficient description. Had his specification included bone meal, as an example of "oxygenated solution," we might have had an apt analogy. The Mraz amendment, however, simply substituted "bone meal" for "oxygenated solution" which the court quite correctly said, was a substitution of new matter, not previously disclosed. On its face the Mraz case has no present application since here the claims neither present new matter nor enlarge the original specification. Rather, the present claims, by those skilled in the art, have been demonstrated to be an application of the specifications to the original generic formula, as the trial court properly found.

Similarly, In re Collins, 75 F. 2d 1000, 1002, 22 C.C.P.A. 1053, 1055, 25 USPQ 38, 41 (1935), may be distinguished, particularly since it cites and explains In re Mraz in the very terms I have just discussed.

I submit that the authorities relied upon do not apply to, and certainly do not control, the disposition of the issue here presented. Rather, the District Court here received detailed and extensive new evidence as to the sufficiency of the disclosure to those skilled in the art. It recognized fully the deference ordinarily due to the findings of the Patent Office but found that the new evidence was clear and convincing, and thus reached "the necessary standard" for thorough conviction, as spelled out in the Esso case, supra.

## IV.

That my affirmative view may more fully appear, in deference to my colleagues, I will analyze the case in detail as I see it.

Bersworth instituted action under the provisions of 35 U.S.C. § 145 asking the District Court to authorize the Commissioner to issue a patent upon certain claims of his application, Serial No. 215,380, filed March 13, 1951, entitled "Hydroxy Derivatives of Alkylene Polyamines."[5] Appellees urged before the Patent Office and in the District Court, and the trial judge found, that certain subject matter had originally been described and claimed and thereafter had been carried continuously in a series of divisional and continuing applications before the Patent Office. The Commissioner argued that the compounds defined in the instant application had been disclosed in two of Bers-

[5] By order of the District Court, pursuant to stipulation, the Dow Chemical Company was added as party plaintiff. It was further stipulated that Claims 1 and 3 might be dismissed without prejudice. Claim 2 defines by formula two compounds, diethanol ethylene diamine diacetic acid and dipropanol ethylene diamine diacetic acid. Claim 4 defines the basic metal salts of the compounds of Claim 2. Claim 2 is typical. This group or class of organic compounds is said to have wide utility in the chemical arts as chelating agents which hold metal ions in aqueous solutions in such form that chemically they are no longer effectively present in the water. In addition, the compounds in question are said to have strong detergent and wetting properties and to be compatible with soap.

worth's patents, publication of which more than one year prior to the date of the instant application raised a statutory bar to the grant here sought. Judge Wilkin's order authorizing relief gave rise to the Commissioner's appeal.

The case turns on the applicability of the doctrine of continuity,[6] both parties being in agreement that the applicant's right stands or falls on the sufficiency of the disclosure[7] in Bersworth's application which matured into patent No. 2,524,218, Case A.[8]

Establishment of the sequence of events importantly requires the interpolation of much detail.

On June 21, 1943, Bersworth filed two applications, one maturing as patent No. 2,407,645 which was issued September 17, 1946, and another, as patent No. 2,428,353 which was issued October 7, 1947. On July 17, 1943, he filed an application for patent No. 2,413,856 which was issued January 7, 1947.[9] While these applications were pending, Bers-

[6] Originating in Godfrey v. Eames, 68 U.S. 317 (1864), the principle of which was recognized in Crown Cork Co. v. Gutmann Co., 304 U.S. 159, 165, 37 USPQ 351, 353 (1938). And see 35 U.S.C. § 120 (1952) as related to 35 U.S.C. § 112 (1952).

[7] See discussion in Commentary on the New Patent Act, 35 U.S.C. App. pp. 31, 33. "The statute is so worded that the first application may contain more than the second or the second application may contain more than the first, but in either case the second application would be entitled to the benefit of the filing date of the first case *with respect to common subject matter*" (Emphasis supplied.)

[8] This patent on appellees' chart, an exhibit of record, is marked "Case A." I will similarly refer to later applications as Case B and Case C and so identify them for present purposes.

[9] The sole ground for Patent Office refusal of a patent in this present case is that the compounds defined in the claims here in issue are disclosed in the two last identified Bersworth patents, relied upon as references. While the inventions actually claimed in 1943 were different, the general subject matter here involved was therein first disclosed. Without more, the publication dates being more than one year prior to the date of the application in suit, these references would bar a grant here. But there is more, as will be seen.

worth, on March 28, 1946, filed application S.N. 657,893 which matured as patent No. 2,524,218, Case A, issued on October 3, 1950.

While Case A was pending,[10] Bersworth on July 17, 1948, filed application S.N. 39,377[11] which remained before the Patent Office until March 21, 1951. As Case B, it was then abandoned, but not until after Bersworth on March 13, 1951, had filed application S.N. 215,380, which is the application in suit.[12] The instant application, Case C, specifically identified its predecessor application, Case B, as a continuation-in-part of the parent application, Case A.[13] Case

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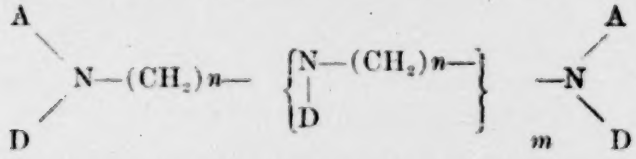
[10] Case A contained a generic claim to compounds as disclosed in the specification but division was required by the Patent Office. Bersworth then on March 15, 1947, filed application S.N. 735,018 which matured as patent No. 2,532,391, issued on December 5, 1950. It defined the broad subject matter by formula almost identically as it appeared in Case A. Case B was likewise so filed.

[11] This is Case B; see note 8 supra.

[12] This is Case C; see note 8 supra.

[13] I quote from the latter, page 1, column 1, lines 25-46, inclusive:

"The alkylene polyamine derivatives of the present invention are represented by the following formula:



where $n$ is either 2 or 3 and $m$ is either zero or a positive integer and wherein D is a member of the group consisting of

$$-CH_2COOH, -CH_2CH_2COOH$$

and their alkali metal salts, and wherein A is a hydrocarbon group containing at least two carbon atoms and having not more than two hydrogen atoms replaced by a member of the group consisting of $-(CH_2)_2COOR$, $-(CH_2)_2COOM$, $-SO_3H$, $-SO_3M$, $-OR$ and $-OR'OR$ wherein R is alkyl or hydrogen, M is an alkali metal, and R' is alkylene, said groups being spaced at least two carbon atoms from the nitrogen atoms."

C, like abandoned Case B, contained a specific claim to the chemical compound included within the subject matter of Case A, but particularly defined by name and by formula in Case C.

Thus at all times here involved there were before the Patent Office, co-pending applications involving the same subject matter, the inventiveness of which has not been challenged. The Commissioner's brief tells us that "as to all common subject matter carried over into the continuing application from the parent application, the former is entitled to the benefit of the latter. * * * What is in dispute here is appellees' claim of right to rely upon the application which matured into Patent No. 2,524,218, [Case A] a bridging application, for the specific subject matter of the claims in issue, [Case C], which subject matter was first specifically disclosed in intermediate application Serial No. 39,377, [Case B]."[14]

Patent Office counsel urged before Judge Wilkin that the applicant must show he could be entitled to claim the specific compound under the disclosure in Case A, and that the evidence showed "that he did not disclose it by name."[15] The names of the compounds do not appear in Case A.[16] But they are formulated.

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[14] Appellant's Br. 8.

[15] It is not suggested how there can be, by itself, a meaningful "name" of a newly discovered chemical compound. A formula which dictates to one skilled in the art the steps to be taken in the composition of matter would seem a preferable form of disclosure. Common salt may be known to us as a colorless or white crystalline substance; it may be known chemically as *sodium chloride;* but if it is identified as NaCl, it is the same the world over, it is nothing but common salt. Compare Lamm v. Watson, 138 F. Supp. 219, 108 USPQ 203 (D.C.D.C. 1955).

[16] "Appellant concedes that the general formula is the same in all three of these cases. * * * However the claims at issue are specific, not broad. Claim 2, for example, is clearly and expressly limited to two distinct compounds, the diethanol ethylene diamine diacetic acid and the dipropanol ethylene diamine diacetic acid." Appellant's Br. 11.

Appellees' counsel agreed that the issue had been "pinpointed"; thus, "if the disclosure of our Case A specifically gives us the compound we have in Exhibit 5, we are certainly entitled to this patent."

In evaluating the legal sufficiency of appellees' parent disclosure,

> "• • • an inventor is required in his application for a patent to disclose the invention in such full, clear, concise, and exact terms as to enable one skilled in the art to make, construct, compound, and use the same. There is no requirement in [35 U.S.C. § 112 (1952)] that a party relying on a constructive reduction to practice to establish priority of invention must show a specific working example to support the compound claimed. For this reason, if compound 17 would be the natural and expected result achieved by one skilled in the art following the procedures outlined by appellees in their parent specification, such disclosure must be regarded as sufficient."[17]

The court in the Lawson case adopted the opinion of the majority of the Board of Patent Interferences, from which it quoted at length:

> "After careful consideration of the parent disclosure we are satisfied that a person skilled in the art, following the general and specific teachings therein, would encounter no difficulty in producing compound 17. • • • it is not denied by the examiner, or the senior party that compound 17 can actually be produced by following closely the analogous and general procedures disclosed in the parent application. We appreciate that it may involve some judgment on the part of the skilled worker. This, however, is true even in cases where examples are given since obviously every detail of the necessary procedure cannot be given in a patent specifi-

[17] Lawson v. Bruce, 222 F. 2d 273, 278, 42 C.C.P.A. (Patents), 893, 105 USPQ 440, 444 (1955); and see In re Gebauer-Fuelnegg, 121 F. 2d 505, 28 C.C.P.A. (Patents) 1359, 50 USPQ 125 (1941); United States Rubber Co. v. Marzall, 91 F. Supp. 1, 86 USPQ 441 (D.C.D.C. 1950).

cation and many details must be left to the skill of the chemist.'"[18]

The appellees offered evidence to establish that organic chemical nomenclature gives a skilled chemist a word picture of the structural formula of an organic chemical compound, that a structural formula gives a skilled chemist a word name for an organic compound, and that the word code conveys a description of organic chemical structure so that chemists can reproduce that structure. Accordingly, an organic formula written in structural form is the equivalent of an organic name derived from the rules of nomenclature in common use in organic chemistry. The trial judge correctly received the evidence of the experts as to what is understood and applied by those engaged in the art of organic chemistry, in order to resolve and to decide a question of fact.[19] Against that background and with the formula[20] at hand, the witnesses traced the successive steps leading directly to the elected species defined in appellees' claim 2.[21] The trial judge specifically found:

"12. The evidence before this Court was clear and convincing that the symbols set out in the formula as

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[18] Lawson v. Bruce, supra note 17, 222 F. 2d at 277, 42 C.C.P.A. (Patents) at 892, 105 USPQ at 443.

[19] Research Products Co. v. Tretolite Co., 106 F. 2d 530, 533, 43 USPQ 99, 101-102 (9 Cir. 1939); cf. International Standard Electric Corp. v. Ooms, 81 U.S. App. D.C. 215, 157 F. 2d, 73, 70 USPQ 32 (D.C. Cir. 1946); International Standard Electric Corp. v. Kingsland, 83 U.S. App. D.C. 355, 169 F. 2d 890, 78 USPQ 241 (D.C. Cir. 1948).

[20] Supra note 13.

[21] We quote from the Memorandum filed by the trial judge:

"The evidence before this Court was clear and convincing that the symbols, when interpreted in the light of the specifications, did lead those experienced in this field of chemistry and advanced students of such chemistry to the embodiment claimed by the plaintiffs. The testimony of the experts was clear and convincing that the language of the original application, including the chemical symbols, did lead directly to the composition for which the plaintiffs seek a patent monopoly."

in finding 10, when interpreted in the light of the specifications, did lead those experienced in this field of chemistry and advanced students of such chemistry to the embodiment claimed by the plaintiffs. The testimony of the experts was clear and convincing that the language of the original application, including the chemical symbols, did lead directly to the composition for which the plaintiffs seek a patent monopoly.

"13. Claim 2 of the United States Patent Application S.N. 215,380 is specifically supported by the disclosure of United States Patent 2,524,218. In fact, Claim 2 of S.N. 215,380 was directly derived from Claim 1 of United States Patent 2,524,218 as filed.

"14. The Patent Office having conceded that the subject matter of United States Patent Application S.N. 215,380 is inventive, claims 2 and 4 define inventive subject matter."

To recapitulate, the allowed Case A, with its generic claim to compounds in the form in which disclosure appears in the specification, is but a concentrated disclosure of specific formulae for some six compounds, one of which is more specifically defined by the claims in suit.[22] Thus one should look to Case A for the genus of which the instant claims are but species, elected and prosecuted after the required division. The trial judge has found the instant claims are the natural and expected result to be achieved by those skilled in the art following the procedures as specified and accompanying the disclosure in Case A. I believe he was right.

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[22] It would seem beyond question that the subject matter of the invention was continually before the Patent Office. Godfrey v. Eames, supra, note 6; Field v. Colman, 40 App. D.C. 598, 606 (D.C. Cir. 1913), cert. denied, 231 U.S. 747 (1913). Thus, cases such as In re Stoll, 161 F. 2d 241, 34 C.C.P.A. (Patents) 1058, 73 USPQ 440 (1947), do not apply

Filed Feb. 28, 1958

**Order**

Upon consideration of appellees' petition for rehearing and of appellant's answer, it is

ORDERED by the Court that the aforesaid petition be, and it is hereby, denied.

PER CURIAM.

Dated: February 28, 1858

Circuit Judge Danaher would grant the petition for rehearing.

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Filed Feb. 28, 1958

**Order**

There not being a majority of the Circuit Judges of this Circuit in favor of a rehearing of the above-entitled case by the Court en banc, the petition for rehearing en banc is hereby, denied.

FOR THE COURT:

CHIEF JUDGE.

Dated: February 28, 1858

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**Order**

It is ORDERED that appellees' motion to stay the transmission of the opinion and the certified copy of the judgment of this Court to and including April 3, 1958, be, and it is hereby, granted pursuant to Rule 31(k)(2) of this Court.

FOR THE COURT:

JOSEPH W. STEWART, *Clerk*

By: WILLIAM G. SECREST
*Chief Deputy Clerk*

Dated: March 10, 1958.